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NOV 18 2004

OFFICE OF PETITIONS

In re Application of :
Friedman, Gray, Roti, Seaman, : DECISION REFUSING STATUS
Lopata, Cesare : UNDER 37 CFR 1.47(a)
Application No. 10/666,979 :
Filed: 17 September, 2003 :
Atty Docket No. 36287-04402 :

This is in response to the renewed petition filed under 37 CFR 1.47(a) on 29 September, 2004.

The petition is again **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.
FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.
Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 17 September, 2003, without an executed oath or declaration. Accordingly, on 12 December, 2003, a Notice to File Missing Parts of Nonprovisional Application was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on 8 July, 2004, petitioners filed a five (5) month extension of time, a declaration naming Allen R. Friedman, Stephen E. Gray, Stephen L. Roti, David A. Seaman, Benjamin B. Lopata, David, and Kelly Cesare as joint inventors, and signed by all joint inventors except Roti on Cesare on behalf of themselves and the non-signing joint inventors, a petition, petition fee, and the late-filing surcharge. The petition was dismissed on 11 August, 2004.

The present renewed petition was filed on 29 September, 2004. Petitioners again assert that joint inventors Roti and Cesare have refused to sign the declaration. Petitioners have provided a declaration by registered patent attorney Chris L. Holm stating that a copy of the application was sent to joint inventor Cesare's attorney, but that joint inventor Cesare has not returned an executed declaration.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks items (1) and (2).

In regards to item (1), petitioners do not appear to have addressed whether joint inventor Roti was ever sent or presented with a copy of the application as filed (specification, including claims, drawings, if any, and the declaration).¹

Petitioners may show proof that a copy of the application was sent or given to the non-signing inventor for review by providing a copy of the cover letter transmitting the application papers (specification, including claims, drawings, if any, and the declaration) to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign the declaration can be alleged, petitioners must show that a copy of the application was sent or given to the inventor. If the inventor refuses in writing, petitioners must submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of fact.

¹ MPEP 409.03(d).

With regards to item (2) upon further review the declaration submitted with the present renewed petition is defective in that it does not state the citizenship of joint inventors Friedman and Lopata. A statement of the inventor's citizenship is a statutory requirement and cannot be waived.² A new oath or declaration, containing the residence, mailing address, and citizenship of of all inventors and signed by joint inventors Friedman and Lopata in compliance with 37 CFR 1.67 is required.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
 220 20th Street S.
 Customer Window, Mail Stop Petition
 Crystal Plaza 2, Lobby, Room 1B03
 Arlington, VA 22202

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

²35 U.S.C. § 115, MPEP 605.01.